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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wal-Mart Stores, Inc.

Serial No. 75741384

Barbara Waite and Mark Harrison of Venable, Baetjer,
Howard & Civiletti for Wal-Mart Stores, Inc.

Susan C. Hayash, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Hohein, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Wal-Mart Stores, Inc. has filed an application to
register the mark MAIN STREET on the Principal Register
for "copy paper."¹

¹ Serial No. 75741384, in International Class 16, filed June 22, 1999,
based on use in commerce, alleging first use and use in commerce as of
July 21, 1990.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark MAIN STREET, previously registered in both typed form and stylized form (shown below) for, respectively, "greeting cards, calendar cards and imprinted stationery,"² and "imprinted stationery, namely, greeting cards, note cards and postcards; calendars and appointment books; and stationery embossers,"³ that, when used on or in connection with applicant's goods, it will be likely to cause confusion or mistake or to deceive.



Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that

² Registration No. 1,598,575, issued May 29, 1990, to New England Business Service, Inc., in International Class 16. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a 10 year term beginning May 29, 2000.]

³ Registration No. 2,187,933, issued September 8, 1998, also to New England Business Service, Inc., in International Class 16.

are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney contends that applicant's mark is identical to the registered mark in typed form and to the literal portion of the stylized registered mark; and that, therefore, the marks create the identical commercial impressions. The Examining Attorney discounts applicant's evidence of third-party registrations for marks containing the term MAIN STREET for a variety of goods, some in International Class 16, as insufficient to establish that the registered marks are weak.

With respect to the goods, the Examining Attorney contends that the respective goods are likely to be encountered by consumers in the same stores; that applicant's goods are within a reasonable "expansion of trade" of the registrant; and that, therefore, confusion as to source is likely. In support of her position, the Examining Attorney submitted an excerpt purported to be from registrant's Internet web site. The site lists categories of goods and services available for small businesses, including "Office Supplies and Equipment." Under this heading are listed numerous types of products in alphabetical order, including "inkjet laser paper" and "multipurpose paper." We note that the list does not include the goods identified in the cited registrations, nor does the web site page indicate the trademarks used to identify the goods in each category. The Examining Attorney also submitted copies of ten use-based third-party registrations that include, among the goods identified in each registration, both copy paper and one or more of the items in the cited registrations.

Applicant contends that, "regardless of any possible similarities between the Applicant's mark and the cited mark, the substantial differences between the respective goods are such that confusion is clearly not likely."

(Brief, p. 2.) Regarding the goods, applicant states the following (Brief, p. 2):

Applicant's mark covers copy paper. In contrast, the cited registrations cover imprinted stationery, greeting cards and calendars. These goods are different on their face and would not be confused by the purchasing public. The registrant's goods are finished products that would be purchased in limited quantities for special occasions. On the other hand, copy paper is an unfinished product akin to a raw material for use with copying machines and printers and often bought in bulk, for example at wholesale discount stores.

In support of its position, applicant submitted additional pages purportedly from the cited registrant's Internet web site showing that, among the many products listed, only cards and calendars are identified by the MAIN STREET trademark. Additionally, applicant claims that the cited marks are weak and submitted, in support of this position, copies of numerous registrations of third-party marks which include as a part of each mark the term "Main Street" for a variety of goods.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. There is no question that applicant's mark is identical to the mark in cited Registration No. 1,598,575. The design portion of the mark in Registration No. 2,187,933

consists of a simple banner upon which the words MAIN STREET appear in large print beneath a smaller picture of a row of buildings, presumably facing "Main Street." This design reinforces the word portion of the mark. Thus, we find that the commercial impressions of applicant's mark and the design mark in Registration No. 2,187,933 are substantially similar. Moreover, applicant does not appear to argue otherwise.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the cited registrations, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that

some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The goods in the cited registrations can all be categorized, generally, as covering items of stationery materials. Applicant's "copy paper" is clearly also an item of stationery material. The third-party registrations submitted by the Examining Attorney show that single marks are registered for a wide variety of items of stationery materials. Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons*

Co., 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

We find that this evidence of third-party registrations weighs in favor of finding the goods herein to be sufficiently related that, if identified by the same or substantially similar marks, confusion as to source is likely. We are not convinced otherwise by the fact that, while registrant appears to offer copy paper and the goods in its cited registrations, such goods may be identified by different trademarks.

We also find that the third-party registrations incorporating the term MAIN STREET do not establish that MAIN STREET is a weak mark for the goods involved herein. The goods in those registrations are quite different from the goods in this case and are not items of stationery materials. There is one third-party registration that is no longer valid for MAIN STREET for copy paper that had registered subsequent to the cited marks herein. However, it is well settled that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the file of that third-party registration, and in any event, the Board is not bound by decision of an Examining

Attorney in another *ex parte* case. *See, In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

Therefore, we conclude that in view of the identical and substantially similar commercial impressions of applicant's mark, MAIN STREET, and registrant's marks, MAIN STREET in typed form and with a design element, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Finally, it is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The refusal under Section 2(d) of the Act is affirmed.